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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/193,538 11/17/98 BILLING-MEDEL

P 6193.US.P1

EXAMINER

HM22/1026

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SOLAYA, J

ART UNIT

PAPER NUMBER

1655

DATE MAILED:

10/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/193,538

Applicant(s)
Billing-Medel et al

Examiner
Jehanne Souaya

Group Art Unit
1655



☒ Responsive to communication(s) filed on Nov 17, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-51 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-51 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, 38, 41, and 45-49, drawn to BS274 polynucleotides, vectors and host cells comprising the BS274 polynucleotides, and methods of detecting BS274 polynucleotides, classified in class 536, subclass 23.1; class 435, subclass 320.1; class 435, subclass 325; and class 435, subclass 6 respectively.
 - II. Claims 23-32, and 42-44, drawn to BS274 polypeptides, classified in class 530, subclass 350.
 - III. Claims 33-37, 39-40, and 50-51, drawn to BS274 antigens and antibodies, classified in class 424, subclasses 184.1 and 130.1 respectively.
2. The inventions are distinct, each from the other because of the following reasons:

The inventions of groups I-III are patentably distinct because they are drawn to different products having different structures and functions. The nucleic acid of group I is composed of deoxyribonucleotides linked by phosphodiester bonds and assumes the form of a double helix. The polypeptide of group II is composed of amino acids linked by peptide bonds and can assume complex tertiary structures. While the antibody of group III is also composed of amino acids linked by peptide bonds, antibodies are glycosylated and their tertiary structure is unique, where four subunits (2 light chains and 2 heavy chains) associate via disulfide bonds into a Y-shaped

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symmetric dimer. The products of groups I-III can be used in materially different processes, for example the DNA of group I can be used in hybridization assays, the antibody of group III can be used in immunoassays, and the polypeptide of group II can be used to make a fusion protein with an enzymatic function. Consequently, the reagents, reaction conditions, and reaction parameters required to make or use each invention are different. Therefore, the inventions of groups I-III are patentably distinct from each other.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, and because the search required for Group I is not required for Groups II or III restriction for examination purposes as indicated is proper.

4. A telephone call was made to Cheryl Becker on October 21, 1999 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any


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amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Souaya whose telephone number is (703)308-6565. The examiner can normally be reached Monday-Thursday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-3014.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Jehanne Souaya
Patent examiner

Oct. 21, 1999


LISA B. ARTHUR
PRIMARY EXAMINER
GROUP 1800